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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/977,644	11/24/1997	RALPH EMERSON	PROG.003.00U	3349

7590 04/19/2004

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EXAMINER

LEVY, NEIL S

ART UNIT PAPER NUMBER

1616

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/977,644

Applicant(s)

EMERSON ET AL.

Examiner

Neil Levy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,7,8,12-14,16,18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,8,12-14,16,18 and 21-24 is/are rejected.
- 7) ☒ Claim(s) 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Receipt is acknowledged of amendment response of 2/26/04.

Applicant questioned need for a supplemental declaration. Please see MPEP 1444 (last paragraph of page 1400-45 through 1400-46 of August 2001 MPEP).

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 7, 22-24 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Applicants arguments to 112 rejections consist of reliance on incorporated patent and application. Subject matter to provide sufficient support for one of ordinary skill in the insecticide arts to enable the claims. Additional support for inclusion of ants as target pests of the aqueous and the solid compositions of claims 1, 4, 5, 22 and 23 are stated to be based on original claim 6. We concur in general with applicants identification of support, however some areas are not so evident, and rejections are maintained as follows. If support is in fact present in either the specification as filed or the applications or patents stated to be incorporated by reference, examiner requests that those documents be identified and the relevant sections be copied and submitted to assist examiner in determination of such support.

Claims 7, 16, 18, 22, 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Composition and methods requiring binding to solid support and to baits now are free of antioxidants, other than the claimed compounds. This is contrary to the original patent claims. It is also contrary to the specifications; at col.3, lines 24-30, solutions "bound to solid supports" are not applied, except as powder or in a trap. Thus, claim 22, aqueous, continuous to be not supported. See also lines 45-54 of col.3, here sprays or bound compositions are taught. Further, oxidation is identified as a problem when solid carriers are used. We therefore fail to see the new matter, of "-free of antioxidants-" of claims 7, 12-14, 16, 18, 22, 23 and 24, as being supported. Further, non-patent literature is not incorporatable by reference into US Patents for critical material. Claims 12-14 and claims 16, 18 are included in this rejection as now limited to free of antioxidants.

Claims 7, 12-14, 16, 18 and 22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection of record is maintained and extended in view of current amendment to the "-free of antioxidant-" as indicated above, examiner is

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unable to find support to counter applicants' statements as to the use of solid supports, as baits, in aqueous formulations or in the claim 23 method of application to an infested area.

At this point it is not clear what art may be relevant, as the newly amended claims require a new search. We await determination of either identification of support for the current amendments/or further amendment to remove the new matter. However, applicant is requested to consider overlapping subject matter in pending applications and in US Patents which would be subject to double patenting consideration.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Hutchings 4861514.

The rejection of record is maintained. Claim 16 list only 1, of 7 initiators, including cinnamic aldehyde, at 0.01-to 1% (from claim 9) language. At Table VIII, of example 4, cinnamic aldehyde is only one of 9 selections present; no other antioxidant is present. Thus, Hutchings teaches the single component of cinnamic aldehyde, in compositions free of antioxidants. We agree Hutchings also teaches combinations. Since examples are provided, we can not see Hutchings with blinders on to either multiple or single presumed antioxidants.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Spertus et al 4477361.

The rejection of record is maintained. See claim 1, cinnamic aldehyde is one of only 4 ingredients to choose, not a mixture thereof –there is no antioxidant.

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Claims 1, 4, 5, 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Narasaki et al JP 64016706.

The rejection of record is maintained. Examiner finds Narasaki repeatedly uses the language "singly or as a combination" (claim 1, top, p.5). Also, p.7, lines 4, 5 specify one of the synergists or at least two. Then, the practical example in fact uses only 1. Therefore if weight is given to one or singly, we must choose among 23 synergists. Some would call the selection of any one of the 23 as anticipatory, others, obvious.

Claims 7, 12-14, 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Howell et al 5102675 with explanation of Twydell et al 4833158 or Thomas et al 5691383.

The rejection of record is maintained.

Howell meets the instant claims, because applicants' intended means of binding is buried in the incorporated references and lacks a definition format. Thus, to limit the concept of binding the argued for ligand, identified in the specification, would need to be claimed-otherwise Howell provides binding.

Claims 7, 12-14, 16, 21, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando et al JP 3-268901 or Tanaka-JP 4176460 or Sugamoto-JP-3081202.

The rejection of record is maintained.

As above, the specification of the instant fails to define binding as requiring a Ligand or Linker. Lines 41-64 of col.4, which applicant relies on specifically recites coupling optionally though a linker (line 42, second word).

Applicant's arguments filed (1/36/04) have been fully considered but they are not persuasive. Applicants arguments have been addressed above rejections dropped have been in response to applicants amendments and identification of support. The open language used in the claims precludes withdrawal of nonobvious and anticipatory rejections, where art rejections are maintained, where other actives than cinnamic or coniferyl aldehyde are disclosed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is 571-272-0619. The examiner can normally be reached on Tuesday through Friday from 7a.m to 5:30p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



NEIL S. LEVY
PRIMARY EXAMINER